

### **REMARKS**

Reconsideration of this application is respectfully requested. Claims 1-10 are pending in this application. Claims 1-10 stand rejected. The rejections set forth in the Office Action are respectfully traversed below.

#### **Claim Rejections-35 U.S.C. §102**

Claims 1-2, 5-6 and 9-10 were rejected under 35 U.S.C. §102(e) as being anticipated by **Kudoh et al.** (USP 6,373,714, previously cited). For the reasons set forth in detail below, this rejection is respectfully traversed.

As will be discussed in detail below, it is respectfully submitted that **Kudoh et al.** does not disclose all claimed elements as required under §102. The rejection under §102 repeats the rejection set forth in previous Office Action. Therefore, the remarks below focus on the Examiner's *Response to Arguments* set forth on page 4, Item 5 of the Office Action.

In the Amendment filed on December 29, 2005, it was argued that **Kudoh et al.** do not disclose or suggest “*noise reduction elements each being connected between a power source terminal of the second surface of the first substrate and a power source terminal of the surface of the second substrate.*”

The Examiner responds to these patentability arguments by asserting:

“Examiner disagrees because in column 4, lines 18-28 of Kudoh reference that disclose the electronic part (3) connected between a power source of a voltage control oscillator (a PCB-1) to a power source supply pad of the motherboard (10). Thus Kudoh meets all of the limitation of the claimed invention.”

First, it is respectfully submitted that column 4, lines 18-28 of the **Kudoh et al.** reference cited by the Examiner simply does not disclose or suggest what the Examiner contends this portion of the reference teaches. Initially, it is noted that features discussed the portion of **Kudoh et al.** relied upon by the Examiner (column 4, lines 18-28) are not illustrated in the drawings of **Kudoh et al.** Thus, the written description is the only portion used to support the rejection. Specifically, column 4, lines 18-28 of **Kudoh et al.** state:

Electronic parts relatively unsusceptible to suffer the influence of a noise, such as a capacitor to be connected with an input terminal, an output terminal, and a power source terminal of a voltage controlled oscillator, and a capacitor having each one end connected with a ground as well as to be connected with an input or output pad, a power source supply pad or a ground pad on the mother board 10, are selected as these electronic parts 3. Moreover, the thickness of the plurality of the electronic parts 3 having the terminals 3a to be connected to the mother board 10 is set to have the lower surface thereof flush with each other.

Thus, the portion of **Kudoh et al.** relied upon by the Examiner teaches two examples of electronic parts unsusceptible to the influence of noise. The first example of such electronic parts is *“a capacitor to be connected with an input terminal, an output terminal, and a power supply terminal of a voltage controlled oscillator”*. Thus, this portion of **Kudoh et al.** clearly does not disclose or suggest a capacitor that is connected between a power source terminal of the printed board 1 and a power source terminal of the mother board 10.

In fact, **Kudoh et al.** suggests that the capacitor “connected with an input terminal, an output terminal, and a power supply terminal of a voltage controlled oscillator” has *no connection to the mother board 10*. More specifically, **Kudoh et al.** disclose that the printed board 1 is a voltage controlled oscillator (see col. 3, lines 50-52). Further, **Kudoh et al.** disclose

that certain of the electronic parts 3 are **not** electrically connected to the motherboard 10 (see col. 4, lines 54-63). Thus, the fact that (1) **Kudoh et al.** discloses that the printed board 1 is a voltage controlled oscillator and (2) **Kudoh et al.** discloses that the capacitor is “connected with an input terminal, an output terminal, and a power supply terminal *of a voltage controlled oscillator*” suggests that the capacitor is *only* connected to the printed board, which is the voltage controlled oscillator. Further, the fact that **Kudoh et al.** indicate that certain of the electronic parts 3 are **not** electrically connected to the motherboard 10 reinforces the suggestion that the capacitor is clearly not connected to a power supply terminal of the mother board 10.

The second example of the electronic part provided by **Kudoh et al.** is “*a capacitor having each one end connected with a ground as well as with an input or output pad, a power source supply pad or a ground pad on the mother board 10*”. Unlike the claimed invention, this example of a capacitor in **Kudoh et al.** at best suggests that the capacitor is **connected between a power source pad on the mother board 10 and a ground of the printed board 1.**

The second example of the electronic part provided by **Kudoh et al.** does not disclose or suggest that the capacitor is *connected between a power source terminal of the second surface of a first substrate and a power source terminal of a surface of a second substrate.*

In summary, it is respectfully submitted that **Kudoh et al.** simply do not teach that a capacitor (i.e., a part relatively unsuceptible to noise) is connected between a power source terminal of the VCO (printed board 1) and a power source terminal of the mother board 10.

It is well settled that anticipation under §102 is established only if all the elements of an invention, *as stated in the claim*, are *identically* set forth in a single prior art reference.

Moreover, it is not sufficient that each element be found somewhere in the reference, the elements *must be arranged as in the claim*. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 703 F.2d 1452, 1458 (Fed. Cir. 1984).

**Kudoh et al.** do not disclose or suggest all the elements of the invention as stated in claims 1 and 5. Accordingly, reconsideration and withdrawal of the rejection under §102 are respectfully requested.

#### **Claim Rejections- 35 U.S.C. §103**

Claims 3-4 and 7-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Kudoh et al.** ('714) in view of **McKee et al.** (USP 6,418,029, previously cited).

**McKee et al.** do not alleviate the above-noted deficiencies of **Kudoh et al.** Therefore, each of claims 3-4 and 7-8 patentably distinguish over the combination of references for the same reasons set forth above with respect to claims 1 and 5 by virtue of their dependency therefrom. Accordingly, withdrawal of the rejection of claims 3-4 and 7-8 is respectfully requested.

#### **CONCLUSION**

In view of the foregoing remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

Application No. 10/668,372  
Group Art Unit: 2841

Amendment under 37 C.F.R. §1.116  
Attorney Docket No.: 031193

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" and last name "Schertler" being clearly legible, and "M." in the middle.

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